UNITED STATES DEPARTMENT OF COMMERCE
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | | ATTORNEY DOCKET NO. |
|---|---|---|---|---|
| 08/231,565 | 04/22/94 | KAWAKAMI | Y | 20264124 |

18M1/0923

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| EXAMINER | |
|---|---|
| HUFF,S | |
| **ART UNIT** | **PAPER NUMBER** |
| 1806 | 18 |

**DATE MAILED:** 09/23/97

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Advisory Action

| Application No. | Applicant(s) |
|---|---|
| 08/231,565 | Kawakami et al |
| **Examiner** | **Group Art Unit** |
| Sheela J. Huff | 1806 |

THE PERIOD FOR RESPONSE: [check only a) or b)]

a) ☐ expires _____ months from the mailing date of the final rejection.

b) ☒ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on _____ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

**Applicant's response to the final rejection, filed on** *Sep 19, 1997* **has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:**

☒ The proposed amendment(s):

☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.

☒ will not be entered because:

☒ they raise new issues that would require further consideration and/or search. (See note below).

☐ they raise the issue of new matter. (See note below).

☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: *In claim 58 "(a)-(c)" should be --(a)-(b)--. In claim 63, the terminology "substantially homologous" changes the invention because it changes the nucleic acid sequence. For the nucleic acid to "hybridize" it is complementary and substantially homolgous is similar not complementary to:*

☐ Applicant's response has overcome the following rejection(s):

☐ Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

☒ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:
*see attached*

☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: *62*

Claims objected to: *none*

Claims rejected: *56-61 and 63-65*

☐ The proposed drawing correction filed on _____ ☐has ☐has not been approved by the Examiner.

☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ .

☐ Other

Sheela J. Huff

**SHEELA J. HUFF**
**PATENT EXAMINER**
**ART UNIT 1806**

## ADVISORY ACTION

1. **IF, IF, IF** the amendment filed on 9/19/97 had been entered, the rejections under 35 U.S.C. 112, first paragraph, and 35 U.S.C. 112, second paragraph, would be overcome.

2. With respect to the rejection of claims 56-57 under 102a, applicant argues that the reference does not teach amino acids. Applicant is claiming nucleic acids not amino acids. Additionally, it is well known that nucleic acids encode amino acids.

Applicant argues that there is no guidance in the reference to identifying short peptides reactive with TIL. Because of the terminology "at least" in the claim, the claim is not limited to short sequences, thus the claim still reads on the full -length.

Applicant argues that antibody cannot be equated with TIL. The intended use is inherent in a compound claim. Thus, it is inherent that the compound in the reference has the same function.

3. With respect to the rejection of claim 56 over Kwon et al applicant argues the limitation of "reactive with TIL". Applicant's arguments have been addressed above.

4. With respect to the 103 rejection applicant against argues TIL activity. Applicant's arguments have been addressed above.